

**REMARKS**

***Response to Claim Rejections – 35 U.S.C. §112***

Claims 1, 7-12, 18-22 and 30 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The rejection reads that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention".

A written description rejection under 35 U.S.C. §112, first paragraph, places a burden on the USPTO to present a *prima facie* case that the rejected matter does not meet the written description requirement. See MPEP 2163.04. "A written description as filed is presumed to be adequate, unless or until *sufficient evidence or reasoning* to the contrary has been presented by the examiner to rebut the presumption." *Id.* (Citation omitted). "The examiner, therefore must have a reasonable basis to challenge the adequacy of the written description" and *MUST* present "by a preponderance of evidence why a person skilled in the art would *not* recognize in an applicant's disclosure a description of the invention defined by the claims." *Id.* Emphasis added. Applicant submits that the USPTO has failed to present a *prima facie* case under these requirements and the rejection should be withdrawn.

Independent claims 1, 12 and 30 all recite limitations having a "key blob" and the Examiner has taken the position that there is *no support* in the original specification for a "key blob." Emphasis added. MPEP 2163.06 states in part that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." Thus, matter contained in any one of the specification, claims or drawings of the original application is supported in the application. Original Figure 2 shows both a "First User's Key Blob" 224 and a "Master Key Blob" 226 for both the first data processing system and the second data processing system. In addition, page 11, line 11 through page 12, line 6 disclose the "session keys 224, 226". While different nomenclature is used on Figure 2 and in the specification for elements 224 and 226, the term "key blob" as used in claims 1, 12 and 30 *IS* supported in the original application as filed at least on Figure 2 and page 11. Therefore, withdrawal of this rejection is respectfully requested.

Independent claims 1, 12 and 30 all recite "a session key randomly generated" and the Examiner has taken the position that there is *no support* in the original specification for a session key that was randomly generated. Emphasis added. Applicant points out page 2, lines

7-17 discloses that cryptographic systems commonly use a given set of numbers or digits known as a cipher "key" that may be *randomly chosen* or have special mathematical properties. Emphasis added. Randomly chosen numbers are commonly known in the art as being "generated." Page 7, line 2 discloses that "a session key [is] generated by the system." Additionally, page 11, lines 11-23 discloses that the "second data processing system 204 includes program instructions to generate session key 218." Given that it is common in the art to generate session keys by random number or by other mathematical manipulation, and given that the present application discloses that the session key 218 is generated, surely a person skilled in the art *would* recognize in the disclosure a description of the invention defined by the claims as required by MPEP 2163.04 described above. Therefore, the written description requirement of 35 U.S.C. § 112 is satisfied and withdrawal of this rejection is respectfully requested.

***Response to Claim Rejections – 35 U.S.C. §102***

Claims 1, 7, 8, 12, 18, 19 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Albanese et al (U.S. Patent No. 6,002,768) (Albanese hereinafter). Albanese is not applicable to the above mentioned claims for at least the following reasons:

Independent claims 1, 12 and 30 all recite, among other things, encrypting *data using the session key AND a symmetric encryption routine*. Emphasis added.

The USPTO provides in MPEP §2131 that: "[t]o anticipate a claim, the reference must teach every element of the claim."

Therefore, to support the rejections with respect to claims 1, 7, 8, 12, 18, 19 and 30, Albanese must contain all of the elements in the above-mentioned claims. However, Albanese does not disclose encrypting data using the *session key AND a symmetric encryption routine*.

The Examiner points to column 9, lines 37-43 of Albanese to support his claim that Albanese discloses encrypting data using the session key and a symmetric encryption routine. However, this section of Albanese discloses that the "*session key K<sub>s</sub>* [is] encrypted with a public key", NOT that the session key is *used* to encrypt other data. Thus, the applicant takes the position that the Examiner has misinterpreted the cited section of Albanese. In addition, the "session key", of Albanese, as described in column 5, lines 14-30 and throughout Albanese, *allows participation in a private conference session*. The session key of Albanese is not used in conjunction with a symmetric encryption routine to encrypt data as, required by independent claims 1, 12 and 30. Therefore, Albanese does not disclose every element of these claims. As

a result, the previous rejections based on 35 U.S.C. §102(e) cannot be supported by Albanese as applied to claims 1, 12, and 30. Thus, claims 1, 12 and 30 are allowable. The remaining claims depend from respective ones of the independent claims and are allowable as depending from an allowable independent claim. Withdrawal of these rejections is respectfully requested.

***Response to Claim Rejections – 35 U.S.C. §103***

Claims 9, 10, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese as applied to claims 1 and 12 above, and further in view of Dillaway et al (U.S. Patent No. 5,742,756) (Dillaway hereinafter). Claims 11 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Albanese as applied to claims 1 and 12 above, and further in view of Kruys (U.S. Patent No. 5,555,309) (Kruys hereinafter). These rejections do not apply to the amended claims for at least the following reason:

Claims 9, 10, 11, 20, 21 and 22 are each dependent claims that depend from either independent claim 1 or 12. Thus, these claims are allowable as depending from an allowable independent claim. Therefore, these rejections are defective and should be withdrawn.

In addition to the previous argument, the PTO recognizes in MPEP §2142:

*The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with claims 9, 10, 11, 20, 21 and 22 for the following reasons.

35 U.S.C. §103(a) provides that:

*[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Albanese, Dillaway and Kruys, alone, or in any combination, do not teach a method for encrypting data as claimed. In addition to the shortcomings of Albanese as set forth above, Dillaway teaches in the cited section (Column 3, lines 24-31) a smart card that only holds a private key. However, the smart card discussed on page 10, lines 10-19 of the present application "contains the user's private keys and any public keys, as well as any other data that may be required by the systems with which smart card 134 is utilized." Kruys teaches

in the cited section (column 2, lines 56-67) "*public and private key pairs which share the same key value.*" However, the plurality of *private* keys and the plurality of *public* keys claimed in claims 11 and 22 and described on pages 6, line 26 – page 7, line 9 and throughout the application do not have the same key value. For example, in regards to the *public* key, the session key is encrypted twice, once using the *user public* key and once using the *master public* key. Thus, if the plurality of *public* keys were of the same value, there would be no benefit of encrypting the data twice. Additionally, in regards to the plurality of *private* keys, the session key is decrypted using the *user private* key for one user and the session key is decrypted using the *master private* key for a different or third party user. Here again, if the plurality of *private* keys had the same value, there would be no benefit to having the plurality of keys. Therefore, the teaching of Dillaway and Kruys, when combined with the shortcomings of Albanese, do not teach the claimed subject matter as a whole. As a result, it is impossible to render the subject matter of claims 9, 10, 11, 20, 21 and 22 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 9, 10, 11, 20, 21 and 22, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Albanese, Dillaway and Kruys patents cannot be combined and applied to reject claims 9, 10, 11, 20, 21 or 22 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

*[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*

Here, for all the reasons set forth above, Albanese, Dillaway and Kruys do not teach, or even suggest, the desirability of the combination because neither teaches or suggests providing a method for encrypting data as claimed.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 9, 10, 11, 20, 21 or 22.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 9, 10, 11, 20, 21 and 22. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 9, 10, 11, 20, 21 or 22, and the rejection under 35 U.S.C. §103(a) is not applicable.

#### Conclusion

In view of all of the above, the allowance of all pending claims is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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